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**SEP 09 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Rochman :  
Application No. 10/799,721 : ON PETITION  
Filed: March 15, 2004 :  
Attorney Docket No. 6332.140 DIV :

This decision concerns the June 3, 2004 "37 CFR 1.17(h) Petition to Include Omitted Items" which in essence requests that a May 28, 2004 "Notice of Omitted Item in a Nonprovisional Application" ("5/28/04 Notice") be vacated.

The petition is **DISMISSED**.

The application was deposited on March 15, 2004. As pointed out in the 5/28/04 Notice, this application has been accorded a filing date, but a Figure 7 described in the specification appears to have been omitted from the filed application.

Petitioner asserts that the allegedly omitted Figure 7 was filed with the other application papers on March 15, 2004. In support, the petition is accompanied by a copy of counsel's postcard receipt, indicating filing in the USPTO for this application on March 15, 2004 of, *inter alia*, six sheets of drawings.

A problem exists with the postcard in so far as a portion is not properly itemized. Specifically, the line listing the preliminary amendment does not state a specific number of pages. When the employee who reviewed the postcard also reviewed the file, he would have found six sheets of drawings. Sheet 6 would have been a sheet consisting of Figure 9. Unless the individual who read the postcard actually read the application papers themselves, along with the preliminary amendment, he or she may well have counted the sheet with Figure 9 when he or she verified that at least six sheets of drawings were present.<sup>1</sup> Therefore, the postcard will not serve as *prima*

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<sup>1</sup> Each application received by OIPE must be individually reviewed for compliance with both the statutory requirements for according an application a filing date and for compliance with various requirements of the rules. Many of the applications concern complex technology. Accordingly, the employees of OIPE, who are not trained engineers or scientists, are not expected to make a detailed comparison of the written description, drawings, and preliminary amendments. To do so would require a greater expenditure of time and resources, with a resulting increased cost, than are currently allocated. In the past, applicants and practitioners have indicated to the PTO that such increases are undesired.

*facie* evidence that six sheets of drawings, not including the drawing sheet with Figure 9, were filed on March 15, 2004.

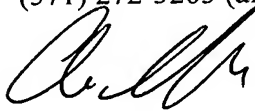
Although one can see rational arguments for more than one interpretation of the contents of the postcard, petitioner bears the burden of proof and the Office will not automatically assume the interpretation most beneficial to petitioner. The Office has considered the contents of the official record and the evidence presented by petitioner. Unfortunately, the current record is insufficient to prove the Figure 7 was filed on March 15, 2004.

Although the petition is dismissed, the Office notes that a viable, and easier, method to add Figure 7 may well exist. An amendment adding Figure 7 may be entered by the examiner *without petition* so long as the amendment contains no new matter. See MPEP 608.02(a). The petition states that an identical Figure 7 was filed in the parent application which is incorporated by reference. Therefore, petitioner may wish to file an amendment adding Figure 7. Adding the figure by amendment, rather than petition, might benefit petitioner in so far as such entry would ensure petitioner that no third party could ever accuse the Office of improperly entering the figure based on a possibly ambiguous postcard.

Since the current record fails to prove the Office sent the Notice in error, the petition fee will not be refunded. The Office notes that \$130 was previously charged to petitioner's deposit account despite the fact that a check for \$130 accompanied the petition. Therefore, \$130 has been credited back to the deposit account.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of March 15, 2004, using the papers filed on that date, and for indicating in the USPTO record that 6 sheets of drawings (consisting of Figures 1-6, 8-9) were present on filing. Thereafter, the file will be forwarded to Technology Center 3600 for examination in due course.

Telephone inquiries should be directed to Petitions Attorney RC Tang at (703) 308-0763 (before September 15, 2004), or to the undersigned at (703) 306-5683 (before September 27, 2004) or (571) 272-3203 (after September 27, 2004).



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